

## **REMARKS**

The above amendments and these remarks are responsive to the restriction requirement dated October 3, 2003. In the restriction requirement, the Examiner requested election under 35 U.S.C. § 121 of a single species for prosecution on the merits from among the 15 different peptides listed in claim 16. In response, applicants hereby elect for prosecution, with traverse, peptide KKLNRTLpSVASL (SEQ ID NO: 18).

### **I. Comments on Previous Restriction Requirement**

Applicants have received and responded to a previous restriction requirement on this application. In the previous restriction requirement, dated September 20, 2002, the previous Examiner on the application, Gailene Gabel, requested election of one of eight groups of claims for prosecution in this application. In response, applicants elected Group I, claims 1-17. Group I was defined as follows:

Claims 1-17, drawn to a method of detecting phosphate group activity on a substrate using luminescence polarization measurement of a luminescent peptide, wherein the peptide includes the sequence:

EKRPpSRPpSYL (SEQ ID NO: 8)  
KRREILSRRPpSYRK (SEQ ID NO: 9)  
KHFPQFpSYSAS (SEQ ID NO: 10)  
pSPELERLIIQC (SEQ ID NO: 11)  
GSPSVRCSpSMpS (SEQ ID NO: 12)  
RSRHSpSYPAGT (SEQ ID NO: 13)  
LpTPLK (SEQ ID NO: 14)  
FpTPLQ (SEQ ID NO: 15)  
RKRpTLRRL (SEQ ID NO: 16)  
LRRApSLG (SEQ ID NO: 17)  
KKLNRTLpSVASL (SEQ ID NO: 18)  
RPRAApTF-NH2 (SEQ ID NO: 19)  
LRRApSLG-NH2 (SEQ ID NO: 20)  
EKRPpSRSKYL (SEQ ID NO: 29) or  
EKRPSQRpSYL (SEQ ID NO: 30).

Applicants traversed the restriction requirement, requesting reconsideration, contending that the restriction requirement was improper. In particular, applicants believed (and continue to believe) that the previous Examiner improperly limited the methods of Group I to those utilizing the sequences set out above. These sequences are not recited in claim 1, but appear to have been selected solely on the basis of their appearance in dependent claim 16. Significantly, claim 16 does not establish the scope of Group I, but instead only the scope of claim 16. Indeed, applicants have amended the claims of Group I in this communication to cancel claim 16. Thus, any limitation imposed by claim 16 should be moot. More generally, applicants have the right to claim their invention using limitations that they select, and the right to have each claim examined on the merits. By arbitrarily truncating the scope of the pending claims in formulating the restriction requirement, the previous Examiner appears to have intended to fail to examine what applicants regard as aspects of their invention. Therefore, in conclusion, applicants respectfully request that the current Examiner examine the claims of Group I, as amended, without the additional sequence limitations imposed by the previous Examiner.

## **II. Comments on Current Restriction Requirement**

In the current restriction requirement, the current Examiner on the application, Ann Lam, requested election of one of the 15 different peptides listed in claim 16 for prosecution in this application. This request is identical to one made by the previous Examiner in the previous restriction requirement. In response to both the current and previous requests, applicants provisionally elect (and have provisionally elected)

peptide KKLNRTLpSVASL (SEQ ID NO: 18) for prosecution. However, applicants traverse (and have traversed) the election requirement, for at least the following reasons. First, as described above, the Examiner reduced the scope of claim 1 in formulating the restriction requirement that underlies the election requirement. For example, the method of claim 1 includes methods carried out both with the peptides identified by the Examiner and with other peptides. Thus, claim 1 as filed encompasses a scope greater than the sum of the methods identified by the Examiner. Second, applicants believe that the 15 enumerated peptides, as well as peptide substrates not enumerated, share many common structural and/or biochemical properties, such that they should be examined together. For example, the peptides comprise useful substrates in a biological assay system for determining phosphorylation or dephosphorylation and so share a common biochemical utility.

Applicants believe that all of the pending claims (namely, claims 1-10, 12, 17, and 47-50) read on the elected species.

Therefore, in conclusion, applicants respectfully request withdrawal of the election requirement, preferably now, but no later than upon allowance of generic claim 1.

### **III. Amendments**

Applicants have amended or canceled several original claims and added several new claims to more particularly point out and distinctly claim aspects of the elected invention.

Applicants have amended claim 1 to focus on aspects of the elected invention touched upon but not limited by claim 9. These aspects, relating to metal ions, are discussed at length in the specification, particularly in Example 9 (pages 47-55).

Applicants have amended claims 2, 3, and 7 to make them stylistically consistent with other pending claims.

Applicants have amended claim 9 to correct a typographical error.

Applicants have amended claims 10 and 17 to focus on aspects of the elected invention of particular current interest.

Applicants have canceled claims 11 and 13-16, without prejudice, reserving their right to pursue these claims later, with or without amendment, in this or a related application.

Applicants have added new claims 47-49, depending from claim 1, to focus on particular aspects of the elected invention. These aspects include generation of a phosphorylated or dephosphorylated peptide (claim 47), use of a stop solution (claims 47 and 48), and use of a microplate sample container (claim 49). Exemplary support for these new claims is found throughout the specification, including Example 6 (pages 40-45).

Applicants have added new independent claim 50 to focus on aspects of the elected invention touched upon but not limited by claims 1 and 10.

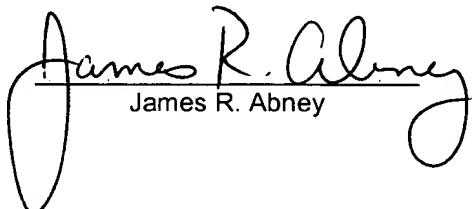
#### **IV. Conclusion**

Applicants believe that this communication is fully responsive to the restriction requirement. However, if there are any remaining matters, or if it would otherwise

advance prosecution of the application, the Examiner is encouraged to call the undersigned attorney at (503) 224-6655.

CERTIFICATE OF MAILING

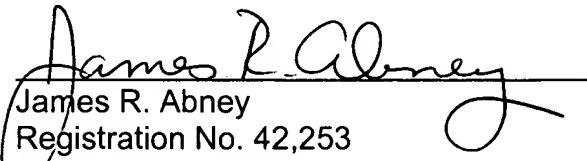
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 5, 2004.



James R. Abney

Respectfully submitted,

KOLISCH HARTWELL, P.C.



James R. Abney

Registration No. 42,253  
Customer No. 23581  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Attorney for Assignee